



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**NOTICE OF APPEAL FROM THE EXAMINER**  
**TO THE BOARD OF APPEALS**

Applicant(s): Renz  
Serial No.: 10/658,308  
For: NIPPLE  
Filed: September 9, 2003  
Examiner: Truong, Kevin Thao  
Art Unit: 3734  
Confirmation No.: 2142  
Customer No.: 67,519 Attorney Docket No.: 460.2173USX

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Dear Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated on the attached sheet(s).

Respectfully submitted,

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March 23, 2010  
Date



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Charles J. Renz  
Serial No.: 10/658,308  
For: NIPPLE  
Filed: September 9, 2003  
Examiner: Truong, Kevin T.  
Group Art Unit: 3731  
Confirmation No.: 2142  
USPTO Customer No.: 27623 Attorney Docket No.: 460.2173USX

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450**

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Dear Sir:

In response to the final Office Action dated October 23, 2009 (the "Office Action"), for which time has been extended by two months up to and including March 23, 2010, Applicant respectfully files herewith a Notice of Appeal and requests review of the present application before filing an appeal brief.

**Related Appeals**

The undersigned attorney is not aware of any related appeals or interferences.

**Status of the Claims**

Claims 34, 37-44 and 57-64 are pending in this application. Claims 57-64 are allowed. Claims 34 and 37-44 are rejected under 35 U.S.C. §112, first paragraph, as

failing to comply with the enablement requirement. Independent claim 34 stands finally rejected under 35 U.S.C. §102(b) over U.S. Patent No. 2,960,088 to Witz (Witz). Dependent claims 41, 42 and 44 stand finally rejected under 35 U.S.C. §103(a) as being unpatentable over Witz. Dependent claims 37-40 and 43 stand finally rejected under 35 U.S.C. §103(a) as being unpatentable over Witz in view U.S. Design Patent No. D130,791 to Porthouse et al. (Porthouse).

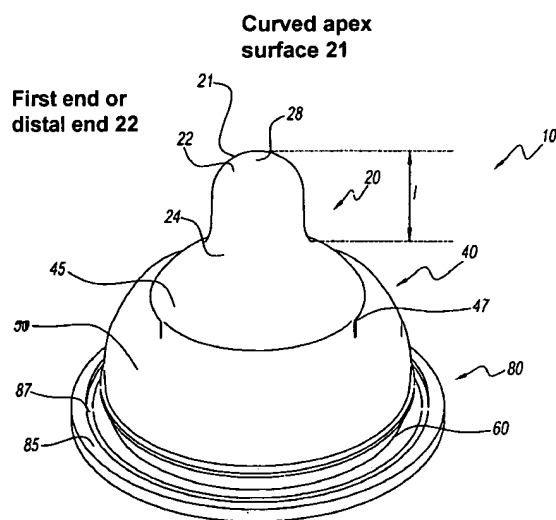
#### Clear Errors for Review

Claims 34 and 37-44 stand rejected as allegedly not being enabled. Specifically, the Office Action rejected the amendment to claim 34 providing that the distal end includes “a curved apex surface” and that the stem is “inwardly tapered from said proximal end toward said curved apex surface”. The Office Action only provides a mere conclusion that the amendment “was not described in the specification in such a way as to enable one skilled in the art to which it pertain, or with which it is most nearly connected, to make and/or use the invention”. Appellant submits that this rejection is inconsistent with both the MPEP and the specification, therefore it cannot be maintained.

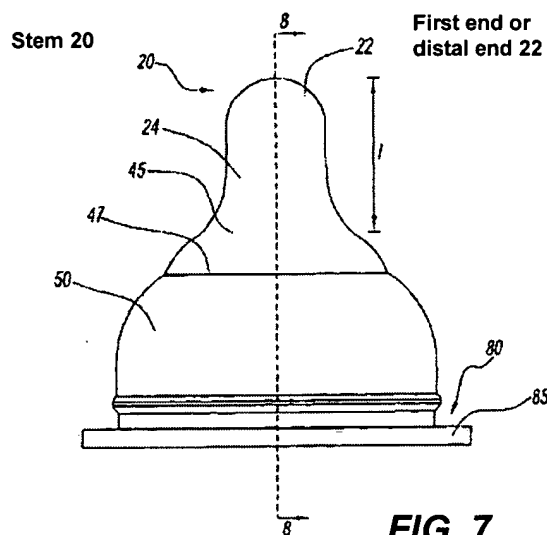
Appellant submits that the Office has failed to satisfy its burden to articulate a prima facie case of nonenablement. See MPEP §2164.04. The Office Action is void of any discussion of even a single Wand factor or any indication that any evidence has been weighed, as the MEPE expressly requires. See MPEP §21640.01(a). Instead, the provided “reason” is a mere conclusion, which the MPEP expressly warns is insufficient to support this rejection. Thus, the Office has failed to meet its burden to establish a “reasonable basis “ for challenging the enablement of claims 34 and 37-44 and Appellant is under no burden to rebut.

However, in the event this rejection is maintained by the Office, Appellant submits that this rejection is erroneous and the amendments are clearly supported by the present specification. The disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. In particular, the amendment is clearly supported

by the present specification on at least a page 6, lines 1-10, reciting that "stem 20...is tapered toward a curved apex surface 21 of first end 22" and is also clearly illustrated in Figs. 4 and 7 of the present application shown below.



**FIG. 4**



**FIG. 7**

Accordingly, it is respectfully submitted that the rejection of claims 34 and 37-44 under the first paragraph of 35 U.S.C. §112 is clearly erroneous and withdrawal of this rejection is requested.

The Office Action asserts that Fig. 1 of Witz illustrates a nipple having an areola region that is connected to the proximal end of the stem and a bulbous region being connected to the areola region. Appellant respectfully disagree.

As argued in our prior response to non-final Office Action dated June 17, 2009, the marked version of Fig. 1 by Witz contains label descriptions that clearly mischaracterize the components of Witz and contradict the specification. In actuality, Witz provides for a bulbous region connected to the proximal end of the stem as provided in both the present specification and in Fig. 1. Thus, Witz fails to disclose or suggest the areola region that is connected to the stem, and the bulbous region that is then connected to the areola region, as recited in claim 34.

Furthermore, Witz fails to provide that the distal end includes "a curved apex

surface" and that the stem is "inwardly tapered from said proximal end toward said curved apex surface", as recited in independent claim 34 (emphasis added). This is illustrated in the marked version of Figure 1 of the present application shown below.

Instead, as is clearly seen from the marked version of Figure 1 of Witz shown below, the stem that is tapered in a direction opposite to the inwardly tapered stem as recited in claim 34. Stated another way, Witz discloses a stem that is wider where it connects to the curved surface of the distal end and then inwardly tapers toward its proximal end where it connects to bulbous region 8.

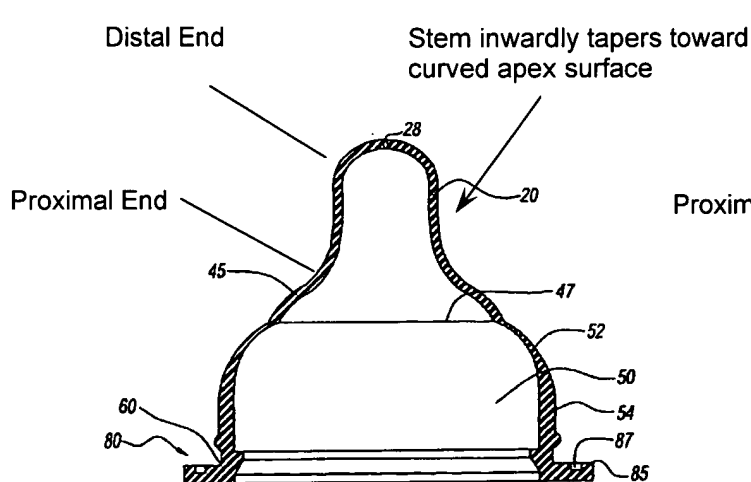


FIG. 8 of present application

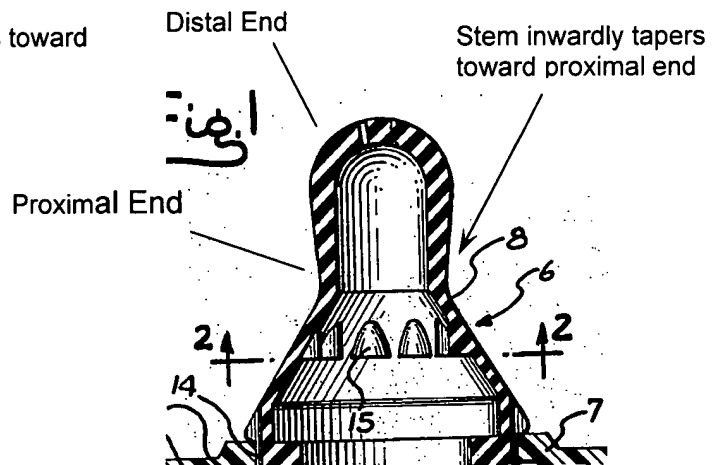


FIG. 1 of Witz

Moreover, Applicant submits that Porthouse fails to cure the above noted deficiency of Witz. Rather, Porthouse is a design patent disclosing a nipple having the shape shown in Figures 1 which is reproduced below.

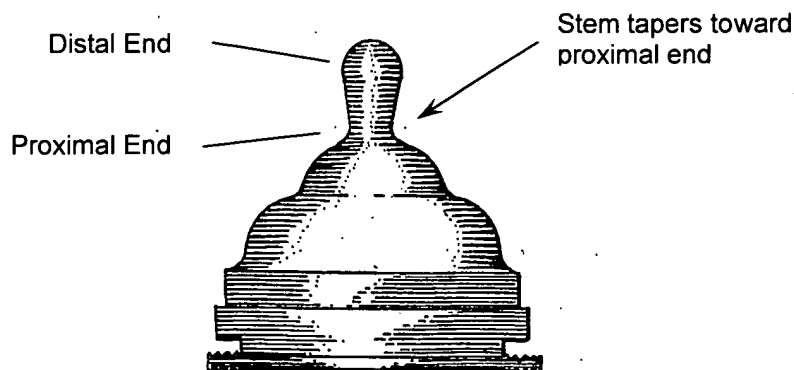


FIG. 1 of Porthouse

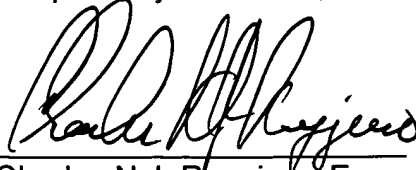
Porthouse, much like Witz, discloses a stem that tapers in the direction opposite to that recited by claim 34. More specifically, Porthouse discloses a nipple that tapers toward the proximal end of the stem.

Moreover, Appellant respectfully submits that the feature of a stem inwardly tapering from the proximal end toward the curved apex surface is not arbitrary. The tapered shape of the stem towards the curved apex surface promotes proper latch-on by the baby. During breast-feeding, the baby latches on to the areola region of the woman's breast. Conventional nipples (similar to Witz) often promote latching on to the stem by having an indent located along the proximal end of the stem. This is improper latching, and promotes "nipple confusion," causing the baby to forget how to properly latch-on to a mother's breast.

Accordingly, Witz alone or in combination with Porthouse, fails to disclose or suggest claim 34. Therefore, claim 34, as well as claims 37-44, that depend therefrom, are in condition for allowance.

In view of the above, it is respectfully submitted that the final rejection is clearly erroneous and, as such, the present application is in condition for allowance. Reconsideration and withdrawal of the rejections to the claims and passage of the present application to issuance are respectfully requested. Such as action is solicited.

Respectfully submitted,



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